

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MINE DESIGN D/B/A/ OF AMAL FLORES  
(U.S.),

Opposer,

v.

VOTIVO, LTD., a Washington corporation,

Applicant,

VOTIVO, LLC, a South Carolina Limited  
Liability Company,

Defendant.

VOTIVO'S REPLY TO MINE DESIGN'S  
RESPONSE TO VOTIVO'S MOTION FOR  
LEAVE TO SUPPLEMENT RECORD IN  
SUPPORT OF MOTION FOR  
RECONSIDERATION

Opposition No. 91178747

# 76613881

**A) VOTIVO's Motion Is Not Seeking Consideration of an Unpleaded Claim or Defense in Violation of TBMP 528.07(b).**

Mine Design argues that VOTIVO's motion raises new arguments not presented in VOTIVO's original summary judgment motion, in violation of TBMP 528.07, which provides: "A party may not defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense." VOTIVO's motion addresses the effect of the Court's Order on the issue of Mine's Design's standing to oppose Votivo's registrations in the TTAB. Thus, VOTIVO's motion clearly does not seek to add an unpleaded claim or defense. Instead, VOTIVO submits that the Court's Order clarifies and supports



VOTIVO's argument that Mine Design lacks standing to oppose VOTIVO's registrations, including MANDARINE.<sup>1</sup>

The Court's Order affirmed that under the Settlement Agreement, Mine Design agreed that it would not directly or indirectly use any of the marks set forth in the Permanent Injunction, including MANDARINE. It follows that if Mine Design cannot use MANDARINE, it cannot possibly have standing to oppose MANDARINE before the TTAB.

Further, the Court's Order clarified that Paragraph 8 of the Settlement Agreement provides that in the event Mine Design begins to use an infringing mark, and the parties are unable to resolve the dispute within a 30-day notice period, VOTIVO may bring a new lawsuit. Since the Settlement Agreement does not provide the opportunity for Mine Design to oppose Votivo's registrations in the TTAB, Mine Design has no standing to oppose MANDARINE in the present action.

**B) The Mine I Order establishes that Mine Design has no standing to oppose VOTIVO's marks before the TTAB.**

The Settlement Agreement would be rendered meaningless if Mine Design were permitted to challenge Votivo's marks in the TTAB. Such a construction of the Settlement Agreement would violate the spirit of the Agreement, which the Court stated as providing, "a remedial procedure for the full range of future trademark

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<sup>1</sup> VOTIVO has appealed the Mine I Order. However, VOTIVO believes (1) supplementing the record with the Mine I Order provides a complete record given the pending motions for reconsideration, and (2) the Mine I Order, even if properly subject to appeal, nonetheless resolves the standing issue before the Board.

disputes, while limiting 'further cost, expense, or continued litigation.' " Mine I Order, p.5. By construing the Settlement Agreement as providing the remedial procedure for trademark disputes, the Court has effectively resolved Mine Design's lack of standing in the present case.

**CONCLUSION.**

VOTIVO requests that VOTIVO's Motion for Leave to Supplement Record in Support of Motion for Reconsideration be granted, and Mine Design's Opposition be dismissed with prejudice.

DATED: May 6, 2009.

Respectfully Submitted,

INVICTA LAW GROUP, PLLC

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